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**OFFICE OF PETITIONS
AND PATENTS**

In re Patent No. 4,670,444
Issue Date: June 2, 1987
Application No. 06/614,923
Filed: May 29, 1984
Inventor: Klaus Grohe et al.

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ON PETITION

This is a decision on the communication filed July 10, 1995, which is being treated as a petition under 37 CFR 1.182 requesting that the terminal disclaimer under 35 U.S.C. § 253 filed on February 21, 1992 be withdrawn in favor of a newly submitted terminal disclaimer.

The petition is granted to the extent indicated below.

BACKGROUND

The above-identified patent issued on June 2, 1987.

A terminal disclaimer under 35 U.S.C. § 253 and 37 CFR 1.323 was filed on February 21, 1992. The terminal disclaimer filed on February 21, 1992 states, in part:

Bayer Aktiengesellschaft hereby disclaims the terminal part of U.S. Patent No. 4,670,444 which extends beyond October 01, 2002, the earlier of the expiration dates of U.S. Patent No. 4,544,658 (issued October 01, 1985) and 4,556,658 (issued December 03, 1985)....

The instant communication was filed July 10, 1995, and requests that the terminal disclaimer filed on February 21, 1992 be withdrawn in favor of a newly submitted terminal disclaimer that disclaims the terminal part of the above-identified patent which extends beyond the earlier of the expiration dates of U.S. Patent No. 4,544,658 and 4,556,658.

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STATUTE AND REGULATION

35 U.S.C. § 253 states that:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. § 255 provides that:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.182 provides that:

All cases not specifically provided for in the regulations of this part will be decided in accordance with the merits of each case by or under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.323 provides that:

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A request for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

OPINION

Petitioners argue that the expiration date of U.S. Patent No. 4,544,658 is now December 9, 2003, and that the expiration date of U.S. Patent No. 4,556,658 is now April 24, 2004 in view of the changes to 35 U.S.C. § 154(c)(1) contained in Public Law 103-465, § 532, 108 Stat. 4809 (1994). Therefore, petitioners request that the terminal disclaimer filed on February 21, 1992 be withdrawn in favor of a newly submitted terminal disclaimer.

The rules of practice do not provide the withdrawal of a terminal disclaimer that was properly recorded in an application or patent. As such, the instant communication is being treated as a petition under 37 CFR 1.182 requesting that the terminal disclaimer under 35 U.S.C. § 253 filed on February 21, 1992 be withdrawn in favor of a newly submitted terminal disclaimer. In accordance with petitioners' authorization, the \$130.00 petition fee will be charged to Deposit Account No. 02-1445 in due course.

The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Office (35 U.S.C. § 254) or correction of the named inventor (35 U.S.C. § 256). In addition, while the instant petition involves a disclaimer, 35 U.S.C. § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Finally, petitioners have not sought amendment or correction by reissue (35 U.S.C. §§ 251 and 252).

As stated in section 1490 of the Manual of Patent Examining Procedure (MPEP),¹ the mechanisms to correct a patent (i.e.,

¹ 6th Ed., Rev. 1 (1995).

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certificate of correction (35 U.S.C. § 255), reissue (35 U.S.C. § 251), and reexamination (35 U.S.C. § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner (e.g., intervening rights in the case of a reissue patent). See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935).

In any event, to withdraw the terminal disclaimer filed on February 21, 1992 and properly recorded in the above-identified patent, such action must be authorized pursuant to 35 U.S.C. § 255.

A Certificate of Correction under 35 U.S.C. § 255 and 37 CFR 1.323 is available for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pats. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat 1975). Specifically, 35 U.S.C. § 255 requires, *inter alia*, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) would require reexamination. Arnott 19 USPQ2d at 1052. See also MPEP 1490.

The "mistake" at issue involves the inclusion of a expiration date certain (October 1, 2002) in the terminal disclaimer filed on February 21, 1992. This "mistake," however, is not one of a clerical or typographical nature; rather, the terminal disclaimer filed on February 21, 1992 was submitted then intending to disclaim the terminal part of the above-identified patent which extends beyond October 1, 2002. In addition, as this "mistake" involves the expiration date of the above-identified patent (i.e., correction of this "mistake" would result in prolonging the term of the above-identified patent), this "mistake" cannot reasonably be characterized as one of minor character. MPEP 1490.

Since the first requirement under 35 U.S.C. § 255 is not met (i.e., the "mistake" sought to be corrected is not of the type proper for correction under 35 U.S.C. § 255), whether the withdrawal of the terminal disclaimer filed on February 21, 1992

in favor of a newly submitted terminal disclaimer would constitute new matter or require reexamination is moot. Id.

Accordingly, the Certificate of Correction is not available for the requested correction.

Assuming, *arguendo*, that the patent statutes authorized the withdrawal of the terminal disclaimer filed on February 21, 1992 in favor of a newly submitted terminal disclaimer would not constitute an appropriate exercise of the Commissioner's discretion under 37 CFR 1.182 or 1.183 or 35 U.S.C. § 255 and 37 CFR 1.323. Granting the requested relief would operate to evade the requirements of the reissue statutes (*i.e.*, 35 U.S.C. §§ 251 and 252). The remedial nature of reissue notwithstanding, reissue is not available to correct all errors. Specifically, it is the Office's position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. See Ex parte Anthony, 230 USPQ 467 (Bd. App. 1982), affd, Appeal No. 84-1357 (Fed. Cir. 1985); see also MPEP 1490. To grant the requested withdrawal of the terminal disclaimer filed on February 21, 1992 in favor of a newly submitted terminal disclaimer on petition would operate to avoid the requirements of reissue.

Nevertheless, the terminal disclaimer filed on February 21, 1992 disclaims the terminal part "which extends beyond October 01, 2002, the earlier of the expiration dates of U.S. Patent No. 4,544,658 (issued October 01, 1985) and 4,556,658 (issued December 03, 1985)...." Due to the changes to 35 U.S.C. § 154(c)(1) contained in Public Law 103-465, the earlier of the expiration dates of U.S. Patent No. 4,544,658 and 4,556,658 is December 9, 2003. Thus, the terminal disclaimer filed on February 21, 1992 contains an ambiguity, in that it sets forth two (2) dates beyond which the terminal part of the above-identified patent is disclaimed: October 1, 2002, and December 9, 2003 ("the earlier of the expiration dates of U.S. Patent No. 4,544,658 (issued October 01, 1985) and 4,556,658 (issued December 03, 1985)....").

In view of the ambiguity in the terminal disclaimer filed on February 21, 1992 created by the changes to 35 U.S.C. § 154(c)(1) contained in Public Law 103-465, Office records will be changed to indicate that the term of the above-identified patent subsequent to December 9, 2003, the later of the two (2) dates set forth in the terminal disclaimer filed on February 21, 1992, has been disclaimed.

As the above-identified patent does not indicate a date of expiration based upon the terminal disclaimer filed on February

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21, 1992, and the filing of such terminal disclaimer has not been published in the Patent and Trademark Office *Official Gazette*, a Certificate of Correction will not be issued.

CONCLUSION

For the above stated reasons, the request to withdraw the terminal disclaimer under 35 U.S.C. § 253 filed on February 21, 1992 in favor of a newly submitted terminal disclaimer will not be granted.

Patent and Trademark Office records, however, will be changed to indicate that the term of the above-identified patent subsequent to December 9, 2003 has been disclaimed.

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.

The patent file is being returned to Files Repository.



Abraham HersHKovitz, Director
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on July 5, 1995.

Date 7/5/95

By

Leonard Horn
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